

REMARKS

Claims 1- 72 are pending in this application. Claims 1-72 stand rejected. Applicant reserves the right to pursue the original claims and other claims in this application and in other applications.

Claims 1-44, 50-59 and 65-72 stand rejected under 35 U.S.C. § 102 (e) as being anticipated by Perino et al., US Patent No. 6,545,875 (hereinafter "Perino"). The rejection is respectfully traversed and reconsideration is respectfully requested.

On September 12, 2003 Applicant submitted a "Declaration Of Terry R. Lee Under 37 CFR 1.131" (hereinafter the "first Lee Declaration"); Terry R. Lee is the inventor of the claimed inventions. The first Lee Declaration establishes a "prior invention" with respect to the effective date of the Perino reference (i.e., May 10, 2000). That is, the first Lee Declaration establishes conception of the claimed inventions prior to the effective date of the Perino reference (i.e., May 10, 2000) coupled with due diligence from prior to the reference date to the filing date of the present application (i.e., May 31, 2000). See M.P.E.P. § 715.07. "A rejection based on 35 U.S.C. 102(e) can be overcome by . . . [f]iling an affidavit or declaration under 37 CFR 1.131 showing prior invention." M.P.E.P § 706.02(b). Accordingly, Applicant respectfully submits that claims 1-44, 50-59 and 65-72 are allowable over Perino.

The Office Action, however, has stated that the first Lee Declaration is ineffective to overcome the Perino reference. The Office Action states that: (1) the "evidence is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO country prior to the effective date" of the Perino reference; (2) "[t]here is no sufficient evidence (date, for example) of showing the claimed invention is

prior to . . . May 10, 2000"; and (3) "the Declaration fails to comply with the requirement set forth in 37 CFR 1.131." See Office Action p. 2 (emphasis added). Applicant respectfully traverses these arguments.

Initially, Applicant respectfully submits that the first Lee Declaration is not trying to prove an actual "reduction to practice of the invention . . . prior to the effective date" of the Perino reference. Rather, as set forth above, the first Lee Declaration is setting forth evidence establishing conception of the claimed inventions prior to the effective date of the Perino reference (i.e., May 10, 2000) coupled with due diligence from prior to the reference date to the filing date of the present application (i.e., May 31, 2000). According to 37 CFR 1.131(b) and M.P.E.P. § 715.07, one way to establish a prior invention is to show "conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing of the application (constructive reduction to practice)." Thus, it is not necessary for the Applicant to show an actual reduction to practice prior to the Perino reference.

Second, according to the M.P.E.P., "if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date." M.P.E.P. § 715.07. The first Lee Declaration sets forth, with statements "made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above-identified patent," that the claimed inventions were conceived prior to the effective date of the Perino reference (i.e., May 10, 2000). Numerous documents supporting a prior conception of the claimed inventions, including an invention disclosure and diagrams, were attached to the first Lee declaration. Although the dates of these

conception documents were blacked-out, Mr. Lee declared that the dates of these documents were prior to the Perino date. This is all that is required to show the conception date of Applicant's invention. As such, the failure to provide an actual date of conception is not a proper basis for rejecting the first Lee Declaration.

Regarding the Office Action's statement that "the Declaration fails to comply with the requirement set forth in 37 CFR 1.131." Applicant respectfully requests that the Examiner reconsider the first Lee Declaration in light of the foregoing arguments.

Moreover, Applicant is submitting a "Supplemental Declaration Of Terry R. Lee Under 37 CFR 1.131" (hereinafter the "second Lee Declaration"). The second Lee Declaration sets forth evidence that Mr. Lee was on business travel, most of which was outside the United States, during the majority of the period spanning May, 10, 2000 to May 22, 2000. The second Lee Declaration establishes that from May 10, 2000 up to and including May 22, 2000, Mr. Lee was not able to complete his review of the present application due to his extensive business travel commitments. "An applicant may be diligent within the meaning of the patent law when he or she has done nothing, if his or her activity is excused." M.P.E.P. § 715.07(a). Mr. Lee completed his review and approved the filing of the present application merely a few days after his return to his workplace. Thus, the second Lee Declaration is further evidence that the filing of the present application was diligently pursued.

For at least the reasons set forth above, the rejection of claims 1-44, 50-59 and 65-72 should be withdrawn and all of the claims allowed.

Claims 45 and 60 stand rejected under 35 U.S.C. § 103(a) as being obvious over Perino in view of Cargin, Jr. et al., US. Patent. No. 6,023,147, (hereinafter "Cargin"). The

rejection is respectfully traversed and reconsideration is respectfully requested.

As noted above, the Lee Declarations establish a completion of the claimed inventions prior to the effective date of the Perino reference. "Applicant may overcome a 35 U.S.C. 103(a) rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references." M.P.E.P. § 715.02. Since Applicant has established a completion of the claimed inventions prior to the effective date of the Perino reference, and Cargin does not teach or suggest any of the features of the claimed inventions, Applicant respectfully submits that claims 45 and 60 are allowable over the cited combination. Accordingly, for at least the reasons set forth above, the rejection of claims 45 and 60 should be withdrawn and all of the claims allowed.

Claims 46-49 and 61-64 stand rejected under 35 U.S.C. § 103(a) as being obvious over Parino in view of the Handbook of LAN Cable Testing (hereinafter the "Handbook"). The rejection is respectfully traversed and reconsideration is respectfully requested.

As noted above, the Lee Declarations establish a completion of the claimed inventions prior to the effective date of the Perino reference. "Applicant may overcome a 35 U.S.C. 103(a) rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references." M.P.E.P. § 715.02. Since Applicant has established a completion of the claimed inventions prior to the effective date of the Perino reference, and the Handbook does not teach or suggest any of the features of the claimed inventions, Applicant respectfully submits that claims 46-49 and 61-64 are allowable over the cited combination. Accordingly, for at least that reason, withdrawal of the rejection of claims 61-64 is respectfully requested.

In view of the above, each of the presently pending claims in this application is

Application No.: 09/583,883

Docket No.: M4065.0260/P260

believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Dated: February 4, 2003

Respectfully submitted,

By 

Thomas J. D'Amico

Registration No.: 28,371

Gianni Minutoli

Registration No.: 41,198

DICKSTEIN SHAPIRO MORIN &

OSHINSKY LLP

2101 L Street NW

Washington, DC 20037-1526

(202) 785-9700

Attorneys for Applicant